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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,000	11/09/2000	Mark A. Hollar	200	6001

31665 7590 12/13/2004

PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,000

Applicant(s)

HOLLAR, MARK A.

Examiner

Pierre E. Elisca

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mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has made an updated search and found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the prior Office action has been withdrawn and new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 1-73 remain pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-73 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wonfor et al. (U.S. pat. No. 6,381,747) in view of Hunter et al (U.S. Pat. No. 6,647,417).**

As per claims 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Wonfor substantially discloses a method/system of providing copy protection of video analog and digital signals and the like, comprising:

ascertaining terms for providing a protected material to a prospective recipient (see, abstract, col 4, lines 21-67, specifically wherein it is stated that the right holders authorize video service providers to apply copy protection to the program material).

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Wonfor fails to disclose the steps of providing a copy of said protected material to said prospective recipient in accordance with said terms that is information of unauthorized copying of other protected material previously provided to said prospective recipient. The Examiner interprets such type of incentive as a purchaser who has fulfilled a certain requirement with a manufacturer of a product which is not taught by Wonfor.

However, Hunter discloses a music distribution system that a customer can choose to order music at times when content providers offer pricing specials or incentives (see., Hunter, col 4, lines 8-29). Please note that incentives can also be in the form of anything. For example, a person in the business of video or CD can get another copy from a different listing of artists. Accordingly, it would have been obvious to a person of ordinary in the art at the time the invention was made to modify the copy protection of Wonfor by including the limitation detailed above by Hunter because this would enhance customer loyalty and discourage customer from making illegal copies.

As per claims 2, and 22 Wonfor discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 5, lines 7-65).

As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Wonfor discloses the claimed method wherein said providing comprises providing a copy of said protected material to said

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prospective recipient in the form of a file (see., abstract, fig 2, digital video, col 5, lines 30-47).

As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Wonfor discloses the claimed method of embedding an identification of said protected material in said copy prior to providing said copy to said prospective recipient (see., col 7, lines 53-67, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark).

4. Claims 1-73 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sims, III (U.S. pat. No. 6,438,235) in view of Hunter et al (U.S. Pat. No. 6,647,417).

As per claim 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Sims substantial discloses a method/system for providing copy protection of content stored on a bulk storage media, comprising:

ascertaining terms for providing a protected material to a prospective recipient (see., abstract, col 2, lines 21-67, specifically wherein it is stated that under the terms of a license agreement).

Wonfor fails to disclose the steps of providing a copy of said protected material to said prospective recipient in accordance with said terms that is information of unauthorized copying of other protected material previously provided to said prospective recipient. The Examiner interprets such type of incentive as a

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purchaser who has fulfilled a certain requirement with a manufacturer of a product which is not taught by Wonfor.

However, Hunter discloses a music distribution system that a customer can choose to order music at times when content providers offer pricing specials or incentives (see., Hunter, col 4, lines 8-29). Please note that incentives can also be in the form of anything. For example, a person in the business of video or CD can get another copy from a different listing of artists. Accordingly, it would have been obvious to a person of ordinary in the art at the time the invention was made to modify the copy protection of Wonfor by including the limitation detailed above by Hunter because this would enhance customer loyalty and discourage customer from making illegal copies.

As per claims 2, and 22 Sims discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 2, lines 44-62).

As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Sims discloses the claimed method wherein said providing comprises providing a copy of said protected material to said prospective recipient in the form of a file (see., abstract, col 3, lines 35-47).

As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Sims discloses the claimed method of embedding an identification of said protected material in said

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copy prior to providing said copy to said prospective recipient (see., col 1, lines 64-67, col 2, lines 1-13, col 4, lines 25-64, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark or key).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

December 09, 2004